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10/655,959	09/04/2003	Yew Teng Too	006404.P010	1957

8791 7590 11/28/2007
BLAKELY SOKOLOFF TAYLOR & ZAFMAN
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

EXAMINER

GELIN, JEAN ALLAND

ART UNIT	PAPER NUMBER
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2617

MAIL DATE	DELIVERY MODE
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11/28/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/655,959

Applicant(s)

TOO ET AL.

Examiner

Jean A. Gelin

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6,7,10-12,17,18 and 21-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 33-42 is/are allowed.
- 6) ☒ Claim(s) 1,6,7,10-12,17,18,21-23,28-32,43 and 48-52 is/are rejected.
- 7) ☒ Claim(s) 24-27 and 44-47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the Applicant's arguments received August 27, 2007 in which claims 1, 10, 12, and 21 have been amended, and claims 23-52 have been added. Claims 1, 6, 7, 10-12, 17, 18, and 21-52 are currently pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 30-31 and 43-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding to claims 30, 31, and 43, the phrase "adapted to" renders the scope of the claim vague and indefinite.

It has been held that the recitation that an element is "adapted to" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

Regarding claims 44-52, they contain the limitation of claim 43, therefore, they are rejected for the same reasons.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1, 6, 7, 10-12, 17, 18, 21 and 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Want et al. (US Patent Number 5,825,675; hereinafter "Want") in view of Lee (US 6,091,675).

Regarding **claim 1**, Want teaches a portable digital device (FIG. 4A) comprising:
at least two control devices for controlling at least two operating functions of the portable digital device (FIG. 4A, buttons 384, 386, 388; column 7, lines 21-28);
a digital display for displaying information (FIG. 4A display 380); and
a processor (FIG. 2, processor 180) for
rotating the information from a first orientation to a second orientation as a single entity (FIG. 3A to 6B; column 8, lines 11-23); and
wherein the portable digital device remaps the at least two control devices to reverse their operating functions, including operating functions not shown in the digital display (for example, functions such as "UP" and/or "DOWN" depicted in Figures 4A-4B are not shown in the digital display 380, and are remapped once device is in inverted position), to allow for use of the portable digital device in both the first orientation and the second orientation (FIG. 4A and 4B; buttons 388 and 384; column 7, lines 43-58);
wherein the at least two operating functions are selected from the group consisting of: scrolling up and scrolling down (FIG. 3A to 6B; column 10, lines 18-39; column 7, lines 16-58) (for example, Want teaches the functions can be scrolling in any of four

directions possible, column 10, line 24; therefore: menu display move to the right, and menu display move to the left as claimed).

Want clearly teaches reversing the operation function of buttons 384 and 388.

Want fails to specifically teach the at least two operating functions are selected from the group consisting of: track skip forward, track skip back, increase volume, and decrease volume.

However, the preceding limitation is known in the art of communications. Lee teaches an apparatus for driving a CD-ROM having a plurality of sub-icons allocated to keys F2 to F3 as inputs, F2 or F3 can represent the available control function such as track skip back and forward, and volume up and down (col. 3, line 58 to col. 4, line 50). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the technique of Lee within the system of Want in order that the user of CD player can select the desired song he wants to play and manage the volume of the CD player.

Regarding **claim 6**, Want further teaches the limitations in FIGs. 4A and 4B.

Regarding **claim 7**, Want further teaches the limitations in FIGs. 3A-3D.

Regarding **claim 10**, Want further teaches a memory (FIG. 2, memory 172) containing a key map, a first table corresponding to the first orientation, and a second table corresponding to the second orientation (FIG. 5, tables in blocks 408 and 414).

Regarding **claim 11**, Want further teaches the limitations in column 9, lines 32-55 (the displayed information is processed as bit map).

Regarding **claims 12, 23, 32, and 52**, Want teaches a method for reorienting a portable digital device from a first orientation to is a second orientation comprising:

(a) rotating information for display on a digital display of a portable digital device from a first rotation position to a second rotation position (column 9, lines 32-36; FIG. 3A to 6B); and

(b) reversing (column 7, lines 44-47) at least two operating functions of at least two control devices of the portable digital device from a at least one operating function to at least one other operating function (column 9, lines 37-46); wherein the at least two operating functions, including operating functions not shown in the digital display (for example, functions such as "UP" and/or "DOWN" depicted in Figures 4A-4B are not shown in the digital display 380, and are remapped once device is in inverted position), are selected from the group consisting of: scrolling forward, scrolling back, menu display move to the right, and menu display move to the left (FIG. 3A to 6B; column 10, lines 18-39; column 7, lines 16-58) (for example, Want teaches the functions can be scrolling in any of four directions possible, column 10, line 24; therefore: menu display move to the right, and menu display move to the left as claimed).

Want clearly teaches reversing the operation function of buttons 384 and 388. Want fails to specifically teach the at least two operating functions are selected from the group consisting of: track skip forward, track skip back, increase volume, and decrease volume.

However, the preceding limitation is known in the art of communications. Lee teaches an apparatus for driving a CD-ROM having a plurality of sub-icons allocated to

keys F2 to F3 as inputs, F2 or F3 can represent the available control function such as track skip back and forward, and volume up and down (col. 3, line 58 to col. 4, line 50). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the technique of Lee within the system of Want in order that the user of CD player can select the desired song he wants to play and manage the volume of the CD player.

Regarding **claims 17, 29, and 51**, Want further teaches the limitations in FIGs. 4A and 4B.

Regarding **claim 18**, Want further teaches the limitations in FIGs. 3A-3D.

Regarding **claim 21**, Want further teaches a memory (FIG. 2, memory 172) containing a key map, a first table corresponding to the first orientation, and a second table corresponding to the second orientation (FIG. 5, tables in blocks 408 and 414).

Regarding **claim 22**, Want further teaches limitations of the claim in column 9, lines 32-55, FIG. 4A and 4B (displayed information is processed as bit map).

Regarding **claims 28 and 50**, Want further teaches, wherein the control devices further include a third button that provides pause and playback for the portable digital device in the right-hand and left-hand orientations in the same manner in the right-hand and left-hand orientations (i.e., select button is the third button and can be used in the same manner in the right or left hand, fig. 4A-4B).

Regarding **claim 30**, Want further teaches the portable digital device is adapted to be gripped by and substantially fit within and operated by a right hand of the user for the right-hand use, and the portable digital device is adapted to be gripped by and

substantially fit within and operated by a left hand of the user for the left-hand use (figs. 3A-3C and 4A-4B).

Regarding **claim 31**, Want further teaches the portable digital device is adapted for the control devices to be actuated by a single finger within a right hand of the user for the right-hand use, and the portable digital device is adapted for the control devices to be actuated by a single finger within a left hand of the user for the left-hand use (the number of fingers to use to activate the control device illustrated in figs. 3A-3C and 4A-4B is based on the ability of the user not on performance of the technology).

Regarding claims 43 and 49, the claim includes the limitation of claims 23, 30, and 31, therefore, they are rejected for the same reasons recited in claims 23, 30, and 31 above.

Allowable Subject Matter

6. Claims 33-42 allowed.
7. Claims 24-27 and 44-47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments with respect to claims 1, 6, 7, 10-12, 17, 18, 21-23, 28-32, 43, and 48-52 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dunlop	US 2003/0184593	10/02/2003
Hunter et al.	US 6,862,739	03/01/2005
Chao	US 6,851,552	02/08/2005

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean A. Gelin whose telephone number is (571) 272-7842. The examiner can normally be reached on 9:30 AM to 7:00 PM.

Application/Control Number:
10/655,959
Art Unit: 2617

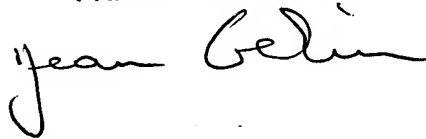
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on (571) 272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JEAN GELIN
PRIMARY EXAMINER

JGelin
November 21, 2007

A handwritten signature in cursive script that reads "Jean Gelin". The signature is written in black ink and is positioned below the printed name and title of the examiner.